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| 10/588,763 | 10/04/2006 | Emile Lopez | 0540-1063 | 4673 |
| <div>466 7590 04/28/2010</div> <div>YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314</div> | | | | |
| <div>EXAMINER</div> <div>JANCA, ANDREW JOSEPH</div> | | | | |
| <div>ART UNIT PAPER NUMBER</div> <div>1797</div> | | | | |
| <div>NOTIFICATION DATE DELIVERY MODE</div> <div>04/28/2010 ELECTRONIC</div> | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary

Application No.

10/588,763

Applicant(s)

LOPEZ, EMILE

Examiner

Andrew Janca

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2010.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-14 is/are pending in the application.
4a) Of the above claim(s) 10 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 5-9 and 11-14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/22)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of group II, claims 5-14 in the reply filed on 3/30/10 is acknowledged.
2. However, claims 5-14 as currently written recite a dependence from cancelled claim 1, to which is objected below.
3. Claim 10 is a process claim which was included in group II due to the examiner's error. Since it properly belongs with group I (and recites dependence from the cancelled claim 2 of group I) it is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as properly being drawn to a nonelected invention, there being no allowable generic or linking claim. Since its omission is due to an examiner's error, it will be treated as an election with traverse which Applicant may traverse in the response to this action if desired; however, affirmation of this election with or without traverse is requested.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

5. Claims 8 and 12 by their dependence from claim 5 recite mechanical transfer means (12, 12') in each chamber. However, these mechanical transfer means (12, 12') recited in claim 5 are described in the specification as parts only in the first embodiment, the embodiment of claims 7 and 11.
6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the mechanical transfer means of claims 8 and 12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

7. Claims 5-9 and 11-14 are objected to as being dependent upon a cancelled base claim.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5-9 and 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. Claims 5-9 and 11-14 are rejected as incomplete because claim 5 recites dependence from a cancelled claim.
11. Claim 6 recites "the outlet of the first chamber". There is insufficient antecedent basis for this limitation in the claim.
12. Claims 9, 13, and 14 recite "the composition catalysts". There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 5-7, 9, 11, and 13-14 are rejected under 35 USC 102(b) as anticipated by US 2,419,876 to Birdseye.

15. With regard to claim 5, Birdseye teaches a device comprising at least one first chamber 12-20 (chambers referred to by floor and ceiling part numbers) provided with mechanical transfer means 20 and means for heating 16 of the radiant type, permitting the worn road coatings to be recycled to reach a first temperature comprised between 105 and 130 degrees C, means 71 for evacuating the gaseous effluents, and a second chamber 29-30 provided with mechanical transfer means 30 and means for heating 16 of the radiant type, permitting the worn road coatings to be recycled to reach a second temperature comprised between 160 and 220 degrees C and means 26-36-71 for evacuation of the gaseous effluents (figure 1; 2:49-50, 6:1ff). It has been held that the manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim. See *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987).

16. The additional elements of claim 6, including means for agglutinating the worn road coatings to be recycled, constricted passage 22-27, disposed at the outlet of the first chamber, are taught by Birdseye (figure 1).

17. The additional elements of claims 7 and 11, including a substantially parallelepipedal chamber 12-20, 29-30 and in that the mechanical means comprise inclined and/or horizontal conveyors 20, 30 provided with means for vibrating 81 (raised portions under the conveyor belt will shake its contents) and means for heating 16 of the radiant type in the form of panels 82, are taught by Birdseye (figures 1, 8-9; 9:35ff).

18. The additional elements of claims 9 and 13-14, including means 70-71-26-36-46 for treating the gaseous effluents emitted from the second chamber including composition catalysts, are taught by Birdseye (figure 1; 7:59-8:1). Composition catalysts may be introduced into the gaseous stream if desired. It has been held that "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim." See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

19. Claims 5, 8-9, and 12-13 are rejected under 35 USC 102(b) as anticipated by US 4,910,540 to Murray.

20. With regard to claim 5, Murray teaches a device comprising at least one first chamber 20-34 provided with mechanical transfer means 82 and means for heating 34 of the radiant type, permitting the worn road coatings to be recycled to reach a first temperature comprised between 105 and 130 degrees C, means for evacuating the gaseous effluents (4:28-65), and a second chamber 18-36-38 provided with mechanical transfer means 82 and means for heating 36-38 of the radiant type, permitting the worn road coatings to be recycled to reach a second temperature comprised between 160 and 220 degrees C and means (4:28-65) for evacuation of the gaseous effluents

(figures 1-2; 2:19ff). It has been held that the manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim. See *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987).

21. The additional elements of claims 8 and 12, including that each chamber 20-34, 18-36-38 comprises first (20, 18) and second (34, 36-38) chambers, which are cylindrical, coaxial, rotatable and inclined, heating means 33, where the worn road coatings to be recycled may be circulated in the space between the two chambers if desired, downwardly by gravity from the top to the bottom, are taught by Murray (figures 1-2; 2:19ff). It has been held that the manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim. See *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987).

22. The additional elements of claims 9 and 13, including means for treating the gaseous effluents emitted from the second chamber including composition catalysts, are taught by Murray (5:32-37). Composition catalysts may be introduced into the gaseous stream if desired. It has been held that "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim." See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,910,540 to Murray in view of US 5,478,530 to Swanson. Murray discloses means for treating the gaseous effluents emitted from the second chamber, duct 30 connected to pollution control equipment (5:32-37), but does not explicitly teach that the means may include composition catalysts. However, Swanson discloses a process for heating a material constituted at least in part by worn road coatings to be recycled (6:43-44), including means for treating the gaseous effluents emitted from the process including pollution control equipment with composition catalysts (6:10-22). It would have been obvious to one of ordinary skill to have provided the pollution control equipment of Murray with the composition catalysts of Swanson: the motivation would have been to reduce environmentally damaging emissions (Swanson 1:7-2:17).

25. Claim 14 is rejected under 35 USC 103(a) as being unpatentable over US 2,419,876 to Birdseye in view of US 6,162,477 to Crisnel et al. Birdseye teaches means 70-71-26-36-46 for treating the gaseous effluents emitted from the second chamber, but does not explicitly teach that they may include composition catalysts. However, Crisnel teach a process for treating food products (13:60-67) prior to packaging with sanitizing and preserving gases, including a discharge to the external

atmosphere of the gaseous effluents with composition catalysts (6:18-25, 6:50-52).

Birdseye and Crisnel are analogous arts, being from the same field of endeavor, preserving foods for packaging. It would have been obvious to one of ordinary skill to use the composition catalysts of Crisnel in the means for treating gaseous effluents of Birdseye: the motivation would have been to sanitize and further preserve the foods of Birdseye, and reduce added sanitizing and preserving gases to a suitable content before exhausting them to the external atmosphere (Crisnel 1:7-10, 6:18-25, 6:50-52).

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Janca whose telephone number is (571) 270-5550. The examiner can normally be reached on M-Th 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on (571) 272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AJJ

/DAVID L. SORKIN/
Primary Examiner, Art Unit 1797